

REMARKS

Reconsideration is requested.

Applicant affirms election of Group I, Claims 31-50. Claims 51-62 have been cancelled. The first and second full paragraphs on page 2, which relate to the non-elected group, have been deleted. Applicant reserves the right to file a divisional application directed to the subject matter of the non-elected group.

The Examiner's indication that Claims 43-49 contain allowable subject matter is acknowledged. New Claim 63 corresponds to Claim 43 including all the limitations of the base claim and intervening claims and is therefore allowable. New dependent claims 64-69 have been added. As Claims 64-69 depend on Claim 63, they too are allowable.

Claim 45 has been amended to avoid use of the adjective "its", to more specifically recite first and second ends, and to rename "member" to --second member-- to more clearly distinguish from the term "operating member." Claims 41-42 and 46-48 have been amended to also change "member" to --second member--. The amendments to Claims 41-42 and 45-48 are merely to clarify antecedent bases and are not intended to narrow the claims.

Claim 40 has been amended in the manner suggested by the Examiner, to obviate the rejection under 35 U.S.C. § 112. The amendment is merely to provide antecedent basis and is not intended to narrow the claim.

Claims 32-45 and 50 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,064,721 to Morgan.

Claim 32, as amended, recites a lock for a wing movable between respective open and closed positions relative to a frame comprising a casing, a bolt operable to extend from or to retract into said casing, an operating member arranged to be operable at one side of

the wing, in use, to effect retraction of the bolt, lock means arranged, in use, for key operation at the other side of the wing, and blocking means operable, in use, to prevent operation of the operating member to retract the bolt, the arrangement being such that, in use, in a locked, closed position of the wing said bolt is extended and said blocking means, if operated, prevents retraction of the bolt by said operating member, key operation of said lock means both de-actuating said blocking means, if operated, and retracting the bolt.

The Morgan reference shows a security locking device which has a fairly conventional thumbturn arrangement at one side of the door and a key-controlled lock at the other side of the door, each of these being operable to extend or retract the deadbolt 9.

Various embodiments of the invention relate to the provision of a base 15 at the inner side of the door principally to house a slidable security bolt 27 which has a finger 26 which can engage into a recess 28 in a wall of a shroud which is rotatable in the base, such rotation rotating the thumbturn. Accordingly, the security bolt 27 can lock the shroud, and thus the thumbturn, against rotation to release the deadbolt 9. Release of the security bolt at the inside of the door is by way of a handle 37 on an operating cylinder 33, whilst at the opposite side of the door release of the security bolt is by way of a key-operated lock 40. In each case, slidable movement of the bolt is by way of an eccentric driving lug 35 or 42 respectively.

Morgan's design requires two separate keys to gain authorized entry from the outside of the door once the locking member has been operated, one key being required to release the security bolt 26, 27, and another key being required to retract the deadbolt. Accordingly, the first key is inserting in the lock 40 and the second one inserted in the lock 12. Thus, as a consequence, the act of releasing the blocking means does not, of course,

also retract the deadbolt as rotation of the key is continued, as is the case with the combination defined by Applicant's Claim 32.

Claim 32 distinguishes over Morgan at least because Claim 32 indicates that key operation of the lock means at the other side of the wing both de-actuates the blocking means and also retracts the bolt. It is also believed to be non-obvious from the disclosure of Morgan to have a single outside key operation which both releases the blocking means and also retracts the bolt.

Therefore, Claim 32 is allowable over Morgan.

As Claims 33-49 depend on Claim 32, they too are allowable over Morgan.

The dependent claims also present additional patentable subject matter. For example, Claim 33 recites that the blocking means can be de-actuated from both sides of the wing. This further distinguishes over Morgan where de-actuation from the inside is by way of the handle 37.

Claims 32 and 35-42 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 3,871,198 to Miller in view of U.S. Patent No. 4,709,566 to Wildenradt.

Miller shows a lock bolt operating handle assembly with a pivotal handle 62, which carries a lock bolt engaging an operating member 58. As can be seen best from Figures 3 and 4, this member 58 is received in a lock bolt 92 so that, in normal operation, pivoting of the handle moves the bolt from its extended position shown in Figure 3 to its retracted position shown in Figure 4 by virtue of the operating member 58 of the handle engaging one side of the recess in the bolt to move it linearly against its biasing spring. Associated with the handle is a lock assembly 66 which is key operated to control a locking member or arm 68. This member 68 is selectively engageable with the operating member 58 so

that it either prevents or allows movement of the member 58, and thus prevents or allows pivoting of the handle and thus withdrawal of the bolt. In other words the member 68 appears to function as a blocking member to prevent retraction of the bolt by the operating member, with key-operation of the lock means de-actuating the blocking means. Figure 3 shows the blocking member actuated, i.e. in engagement with the member 58, whilst Figure 4 shows the blocking means released by operation of the key so that the member 58 can move, allowing pivoting of the handle and withdrawal of the bolt.

Miller fails to disclose lock means arranged for key operation at the other side of the wing, as required by Claim 32.

It would not be obvious to substitute a portion of the structure of Miller for portions of the structure of Wildenradt because there is no teaching in the references of how the components should be combined or of which components of Wildenradt should be selected and somehow combined with components of Miller. There are no teachings in the references themselves which teach that there would be any advantage resulting from selecting portions of the structure of Wildenradt and integrating that structure somehow into the structure of Miller. The mere fact that the structures of the references could possibly be somehow modified to result in the claimed structure does not render the claimed structure obvious unless the references suggest the desirability of the modification. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Evidence of a suggestion to combine may flow from the prior art references themselves, from the knowledge of one skilled in the art, or from the nature of the problem to be solved. However, this range of sources does not diminish the requirement for actual evidence. Further, the showing must be clear and particular.

Wildenradt shows a fairly simple mechanism where both the lock cylinder and the turnpiece at respective opposite sides of the door each have respective operating bars 32, 34 at their respective ends for engaging a crank of the latchbolt assembly so as to retract or extend this bolt. At the inside of the door, the turnpiece can be blocked against rotation to retract the bolt by means of a latching member 56 which is manually operated, which itself can be locked in position by means of a combination lock type assembly.

The structure of Miller does not lend itself easily to incorporation of any form of lock means at the outside of the door to release the arm 68. As can be seen particularly from Figures 3 and 4, it would not be a simple exercise to provide a mechanism at the outside of the door which would act on the member 68 given the positioning of the bolt and its actuating spring in direct alignment with the member 68.

Moreover, there is no teaching or suggestion whatsoever in the disclosure of Miller that release of the blocking member from outside the door is contemplated. The arrangement shown is merely to securely lock the door to the door jamb, but would have application, for example, to prevent a child inadvertently opening the door. There is no teaching or suggestion whatsoever of the purpose of the blocking member being to prevent egress from the inside of the door by a burglar as is the result with the invention recited in Claim 32.

In Wildenradt, operation of the outside cylinder lock 20 has no effect whatsoever on the release of the blocking element 56 which prevents locking of the interior turnpiece against rotation, and thus retraction of the latchbolt from the inside of the door. It will thus be appreciated that with Wildenradt, the outer cylinder lock 20 is not adapted to operate or retract any blocking member but is merely arranged, in a conventional form, with spindle bar means 32 which indirectly acts on the latchbolt linearly to slide it in one direction or the

other. There is no teaching or suggestion at all of adapting this spindle bar means 32 or an extension thereof to retract the blocking element 56 from the outside of the door.

The only plausible explanation for the modification presented by the Examiner is that the Examiner is using the Applicant's disclosure as a roadmap to locate or modify teachings to arrive at the Applicant's claimed invention. Such is impermissible hindsight reconstruction. The motivation for forming a combination of references or modification thereof must be something other than hindsight reconstruction based on using the Applicant's invention as a roadmap for such combination or modification. See, for example, *Interconnect Planning Corp. v. Veil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In Re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990) (explains that hindsight reconstruction is an improper basis for the basis of a claim). For this reason, the obviousness rejection against Claim 32 is improper and should be withdrawn

Therefore, Claim 32 is allowable over Miller in view of Wildenradt. As Claims 33-49 depend on Claim 32, they too are allowable over Miller in view of Wildenradt.

The dependent claims also present additional patentable subject matter.

The Examiner alleges that, as far as Claim 35 is concerned, that the blocking means are operable from one side only of the wing to prevent operation of the operating member to retract the bolt, whilst with regard to Claim 36, the Examiner alleges that Miller discloses that the blocking means are operable by key operable means at said one side of the wing. This is at odds with the Examiner's earlier statement that it would be obvious to modify Miller in view of Wildenradt to provide locking and unlocking access to the bolt from both sides of the wing, given that such statement implies that a combination of Miller and Wildenradt would allow actuation of the blocking means from outside of the door.

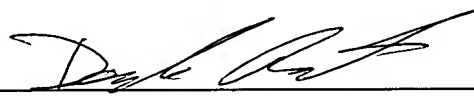
It is respectfully submitted that Claim 35 presents additional patentable subject matter.

In view of the foregoing, allowance of Claims 32-49 and 63-69 is requested.

The Examiner is requested to telephone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time.

Respectfully submitted,

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By: 
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